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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/693,690	10/20/2000	Kia Silverbrook	NPA064US	8647

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EXAMINER

PORTER, RACHEL L

ART UNIT

PAPER NUMBER

3626

DATE MAILED: 03/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/693,690

Applicant(s)

SILVERBROOK ET AL.

Examiner

Rachel L. Porter

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/14/05.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7/21/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the Applicant's responses filed 7/21/05 and 9/14/05. Claims 1-44 are pending. The IDS filed 7/21/05 has been entered and considered.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/14/05 has been entered.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claim 1, the function(s) carried out by the "sensing device" in claim 1 is/are unclear to the Examiner. In particular, it is unclear whether the "sensing device"

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is receiving/sensing the indicating data (as its name suggests) or if it is generating the indicating data. Claims 2-3 inherit the deficiencies claim 1, and are therefore also rejected.

Claim 4 recites similar language to claim 1, and is therefore rejected for the same reasons provided in the rejection of claim 1.

Similarly the function(s) carried out by the "sensing device" in claim 5 is/are unclear to the Examiner. The present claim recites that the sensing device provides the computer system with data regarding the identity of a customer, a form and the position of the device relative to the form in the claim. However, the claim later recites that the sensing device is generating data regarding the identity of the form and its position. Consequently, it is unclear whether the "sensing device" is receiving/sensing the data (as its name suggests) or if it is generating the data.

It is noted that claims 1, 4 and 5 have been amended. However, these amendments do not overcome the 112, 2nd rejections previously set forth. The steps/functions performed in method and by the sensing device remain unclear to the Examiner. For example, in claim 1, the second step is somewhat narrative and does not clearly outline what steps are being performed. While reading claim 1, it would appear that only 3 steps are performed: 1) printing a form containing information relating to an insurance service; 2) receiving in a computer system indicating data from a sensing device regarding the identity of the form and a position of the sensing device

relative to the form; and 3) identifying, in the computer system and from the indicating data, at least one parameter relating to insurance.

It is unclear how additional information provided in the claim (e.g. "and at the same time as printing the information, printing coded data indicative of an identity of the form..." and "the sensing device, when placed in an operative position... sensing coded data and generating the indicating data") relates to the claimed invention.

37 CFR §1.75(i) offers the following guidance:

Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation.

If the Applicant intends to claim the functions of the printing of the coded data and/or the functions of sensing device as a separate steps in the process claim, the Examiner suggests clarifying the claim language and structure (i.e. line indentation) to reflect steps and functions as independent steps, which are actively performed in the claimed method. Also, MPEP 2111.04 provides additional guidance on "intended use" language in claims in "wherein" and "whereby" clauses.

Claims 6-26 inherit the deficiencies of their respective independent claims, and are therefore also rejected.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dougherty et al (USPN 6,076,734) in view of Henderson et al (USPN 5,737,740) and in further view of Luchs (USPN 4,831,526).

As per claims 1-26, Dougherty teaches a method for using a computer system including a sensing device to gather information to determine formatting information (e.g. type of form) and positioning data (i.e. reference point) on an encoded physical medium. (col. 5, lines 22-54; col. 6, lines 11-29; Figure 2). Dougherty further discloses that the computer system identifies parameters relating to the task/application performed (i.e. type of document being generated) (col. 7, lines 57-col. 8, line 10) and provides markings or indicia on the surface of interest to distinguish that surface from other physical media. (col. 5, lines 22-46). Furthermore, the sensing device in the Dougherty reference measures information within a desired region of interest on a physical surface. (col. 7, lines 21-32)

However, Dougherty does not expressly disclose that computer system receives indicating data from the sensing device regarding its position relative to the form or physical medium. Henderson discloses a system and method wherein the position of the sensing device relative to physical media/document is record (xy coordinates) and

stored within the computer system (Figure 1, col. 14, lines 35-55; col.15, lines 10-29) At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method/system of Dougherty with the teaching of Henderson to record information on movement/location of the sensing device relative to the document/physical medium. As suggested by Henderson, one would have been motivated to include this feature to facilitate future access to electronic documents for archival or editing purposes. (col. 3, lines 20-37)

Dougherty and Henderson do also not expressly disclose the invention as it relates to printing and identifying information on forms related to specific types of insurance services.

Luchs teaches a method wherein forms relating to insurance services are generated. (Figures 1, 2E-2F; col. 14, lines 46-15; col. 17, line 31-col.18, line 10) Luchs further discloses a method in which customer data, quote information, insurance policy type, deductible, and claim information may be included as parameters on the insurance forms. (Tables in col. 7-8). At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method of Dougherty and Henderson with the teaching of Luchs to use a computer system with sensing devices to gather information from forms related to various types of insurance services. One would have been motivated to include these features to provide an automated system which properly positions information on regarding various insurance services into the appropriate forms, thereby minimizing the need for repetitive entry of insurance

data for each insurance application (See Luchs: col. 2, lines 6-18) and producing documents that are tailored to an individual client (See Luchs: col. 2, lines 21-25).

As per claims 27-44, Dougherty teaches a computer system including a sensing device to gather information to determine formatting information (e.g. type of form) and positioning data (i.e. reference point) on a physical medium. (col. 5, lines 22-54; col. 6, lines 11-29; Figure 2). Dougherty further discloses that the computer system identifies parameters relating to the task/application performed (i.e. type of document being generated) (col. 7, lines 57-col. 8, line 10) and provides markings or indicia on the surface of interest to distinguish that surface from other physical media. (col. 5, lines 22-46).

However, Dougherty does not expressly disclose that computer system receives indicating data from the sensing device regarding its position relative to the form or physical medium. Henderson discloses a system and method wherein the position of the sensing device relative to physical media/document is record (xy coordinates) and stored within the computer system (Figure 1, col. 14, lines 35-55; col.15, lines 10-29) At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method/system of Dougherty with the teaching of Henderson to record information on movement/location of the sensing device relative to the document/physical medium. As suggested by Henderson, one would have been motivated to include this feature to facilitate future access to electronic documents for archival or editing purposes. (col. 3, lines 20-37)

Dougherty and Henderson do also not expressly disclose the invention as it relates to printing and identifying information on forms related to specific types of insurance services.

Luchs teaches a system further comprising a printer and forms, wherein the forms relate to insurance services. (Figures 1, 2E-2F; col. 14, lines 46-15; col. 17, line 31-col.18, line 10) Luchs further discloses that customer data, quote information, insurance policy type, deductible, and claim information may be included as parameters on the insurance forms. (Tables in col. 7-8). At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system Dougherty and Henderson with the teaching of Luchs to use a computer system with sensing devices to gather information from forms related to various types of insurance services. One would have been motivated to include these features to provide an automated system which properly positions information on regarding various insurance services into the appropriate forms, thereby minimizing the need for repetitive entry of insurance data for each insurance application (See Luchs: col. 2, lines 6-18) and producing documents that are tailored to an individual client (See Luchs: col. 2, lines 21-25).

Response to Arguments

7. Applicant's arguments with respect to claims 1-44 have been considered but are moot in view of the new ground(s) of rejection.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel L. Porter whose telephone number is (571) 272-6775. The examiner can normally be reached on M-F, 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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